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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. **1818-0001**

Application of: **Wesley Stout**

Group Art Unit: **2171**

Serial No. **09/100,934**

Examiner: **Thuy Pardo**

Filed: **June 22, 2002**

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**Technology Center 2100**

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(Date of Deposit)

Michael D. Beck

Name of person mailing Document or Fee

Signature

October 25, 2002

Date of Signature

**LETTER**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

Enclosed are an original and three (3) copies of a Reply Brief in connection with the above-identified patent application. The due date for filing this Reply Brief is two months from the mailing date of the Examiner's Answer (i.e. 10/26/02). Therefore, it is respectfully submitted that this Reply Brief is timely filed.

Commissioner for Patents

August 28, 2002

Page 2 of 2

Please provide any extensions of time which may be necessary and charge any fees which may be due to Deposit Account No. 13-0014, but not to include any payment of issue fees.

Respectfully submitted,



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#42  
**ORIGINAL**  
fwbIN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

11-5-02

MMB Docket No. 1818-0001

Application of: Wesley Stout

Group Art Unit: 2171 2175

Serial No.: 09/100,934

Examiner: Thuy Pardo

Filed: June 22, 1998

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Signature of person mailing Document or FeeOctober 25, 2002

Date of Signature

**APPLICANT'S BRIEF IN REPLY TO EXAMINER'S ANSWER**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of claims 5 and 6 of the above-identified patent application.

Applicant lodged an Appeal Brief on February 1, 2002, to which an Examiner's

Answer was filed on August 26, 2002. The present Reply Brief is in response to the Examiner's Answer, with three copies filed herewith. This Reply Brief has been filed within the two-month period set forth in 37 C.F.R. §1.193(b)(1), so it is believed that no extensions of time are required. However, if an extension is required, Applicant requests that the necessary extension of time be granted. In that event, the Commissioner is authorized to charge any fees which may be due to Account No. 13-0014, but not to include any payment of issue fees.

#### REMARKS

As a preliminary matter, the Examiner pointed out that no statement of related actions was included in Applicant's initial submission. There are no other appeals or interferences involving the present application.

With respect to the Examiner's statement regarding the grouping of the claims, Applicant concurs that claims 5 and 6 stand or fall together.

#### The Obviousness Rejections

In response to the arguments presented in Applicant's Appeal Brief, the Examiner has essentially repeated the grounds for rejecting the subject claims. Applicant does not agree that the Examiner's modulo example is pertinent to the present invention. Nevertheless, assuming that the modulo analogy at page 4 of the Examiner's Answer is appropriate, the Examiner still has not provided support for the modulo-1000 and modulo-365 register example, or the conversion of one modulo register into another. Again the Examiner is obligated to provide support

for the cited examples of modulo arithmetic that the Examiner regards as well-known facts.

The Examiner has acknowledged that the present obviousness determination required hindsight reasoning, but suggests that the rejection did not rely upon knowledge gleaned only from Applicant's disclosure. However, the date addition and optional addition of 635 is not found in any printed prior art publications or in any factual examples of modulo arithmetic. Instead, the Examiner has taken Applicant's teachings and found a theory of mathematics that the Examiner believes explains Applicant's invention. This is improper.

The Examiner suggests that Applicant has not recognized the proper level of skill in the art. To the contrary, the Examiner has not provided any support that knowledge of modulo arithmetic is within the skill of a normally skilled artisan, such as the inventor in the Adamchick patent. On the other hand, Applicant has submitted a prior art document from a trade magazine "Scientific Computing and Automation" that would seem to provide the clearest definition of the proper level of skill and knowledge in the art, a conclusion that is not refuted in the Examiner's Answer. As explained in Applicant's Appeal Brief, this article describes eleven "basic technical solutions" to the Y2K problem. None of these solutions mentions modulo arithmetic, and most significantly, none of these solutions is similar to Applicant's claimed invention.

The Examiner's Answer has not corrected any deficiencies in the original obviousness rejections. The Examiner still has not sustained the burden to establish a *prima facie* case for obviousness of Applicant's claimed invention.

Applicant's 131 Affidavit

In part (B) of the Examiner's Answer, the Examiner again repeated the prior arguments for dismissing the inventor's declarations that establish Applicant's diligence from conception to the constructive reduction to practice. While stating the standard for diligence requires accounting for the entire critical period, the Examiner has also refused to consider Applicant's evidence of substantially continuous diligent activity. The Examiner has discounted the inventor's declarations and documentary evidence as "addressed to offer for use or sale". No support has been provided for the "offer for use" test applied by the Examiner.

With respect to the claim of offer for sale, the Examiner has applied an improper standard to Applicant's documentary evidence. As has been made clear in recent decisions, an offer for sale requires an offer "which the other party could make into a binding contract by simple acceptance". See, Scaltech, Inc. v. Retec/Tetra LLC., 60 U.S.P.Q.2d 1687, 1692 (Fed. Cir. 2001); see also, Group One Ltd. V. Hallmark Cards Inc., 59 U.S.P.Q.2d 1121, 1125 (Fed. Cir. 2001). The question of offer for sale requires application of the principles of contract law regarding sufficiency of an offer to establish a contract. Id.

The Examiner did not provide any support for the unilateral determination that the Applicant's documentary evidence constituted an offer for sale. None of the letters accompanying Applicant's declarations could be construed as an offer to sell the claimed invention under any known contract laws. Unless the Examiner intends to impugn the credibility of the inventor, Mr. Stout's explanation

of his efforts must be accepted. This explanation, together with the documentary evidence accompanying the declarations, establishes the necessary diligence during the critical period and is sufficient to remove the Adamchick patent as a reference.

Conclusion

The Examiner's Answer has not refuted Applicant's arguments set forth in the Appeal Brief and is not sufficient to support either the obviousness rejections or the refusal of Applicant's 131 declarations. Thus, reversal of the final rejection of claims 5 and 6 of the present application is appropriate. Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the final rejection and remand this application for allowance.

Respectfully submitted,



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October 25, 2002

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